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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,915	10/16/2001	Avi J. Ashkenazi	GNE.2630PIC12	8309

7590 03/03/2006

Ginger R Dreger
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275 Middlefield Road
Menlo Park, CA 94025

EXAMINER

BLANCHARD, DAVID J

ART UNIT	PAPER NUMBER
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1643

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/981,915

Applicant(s)

ASHKENAZI ET AL.

Examiner

David J. Blanchard

Art Unit

1643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 61-65, 68-70 and 74-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 63-65 and 68 is/are allowed.
- 6) ☒ Claim(s) 61-62, 69-70 and 74-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Exhibit A</u> . |

DETAILED ACTION

1. Prosecution on the merits of this application is reopened on claims 61-65, 68-70 and 74-75.
2. Claims 1-60, 66-67 and 76-73 are cancelled.
Claims 61-62, 64-65, 69 and 74-75 have been amended.
3. Claims 61-65, 68-70 and 74-75 are pending and under examination
4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. This Office Action contains New Grounds of Rejections.

Rejections Withdrawn

6. The rejection of claims 58-62 and 69-75 under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement is withdrawn in view of applicant's arguments and the amendments to the claims filed 1/11/06.
7. The rejection of claims 58-61 and 71-74 under 35 U.S.C 102(b) as being anticipated by Struyk et al (The Journal of Neuroscience 15(3):2141-2156, 1995) is withdrawn in view of the amendments to the claims.
8. The rejection of claims 58-61 and 69-74 under 35 U.S.C. 103(a) as being unpatentable over Struyk et al (The Journal of Neuroscience 15(3):2141-2156, 1995) in view of Grose (US Patent 5,710,248) is withdrawn in view of the amendments to the claims.

9. The rejection of claims 58-60 and 71-73 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in view of the cancellation of the claims.

Response to Arguments

10. The rejection of claims 61-62, 69-70 and 74-75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is maintained.

The response filed 1/11/2006 does not address the rejection (item no. 14 of the office Action mailed 11/23/05) and as such the rejection is maintained.

New Grounds of Rejections

Priority

The patentable utility for the subject matter defined in claims 63-65, 68 and 74-75 is based on the proliferation of rat utricular supporting cells assay (Example 116 at page 277 of WO 99/46281), which was first disclosed in PCT/US99/05028 (WO 99/46281), filed 3/8/1999 and patentable utility for the subject matter defined in claims 61-62, 69-70 is based on the chondrocyte re-differentiation assay (Example 126 at page 359) which was first disclosed in PCT/US00/04341 (WO 00/53756), filed 2/18/2000. Therefore, claims 63-65, 68 and 74-75 are granted the priority to 3/8/1999 and claims 61-62 and 69-70 (as dependent upon claim 61) are granted priority to 2/18/2000. The

examiner Acknowledges the priority statement in the Office Action mailed 6/20/2005, however, the claims as presently amended recite the chondrocyte re-differentiation utility and therefore are granted priority to 2/18/2000.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

12. Claims 61-62 and 69-70 are rejected under 35 U.S.C. 102(a) as being anticipated by Fukushima et al [a] (WO 99/58668, published 11/18/1999) as evidenced by English equivalent Fukushima et al [b] (U.S. Patent 6,664,383 B1, cited on PTO-892 mailed 6/20/05).

The claims are interpreted as being drawn to isolated polypeptides comprising at least 95% amino acid sequence identity to the amino acid sequence of SEQ ID NO:523, optionally lacking its associated signal peptide or the amino acid sequence of the polypeptide encoded by the full-length coding sequence of the cDNA deposited under ATCC accession number 209487 (i.e., SEQ ID NO:523) wherein said polypeptide induces chondrocyte re-differentiation as well as a chimeric polypeptide comprising any of said polypeptides fused to a heterologous polypeptide that is an epitope tag or an Fc region of an immunoglobulin.

Fukushima et al [a] teach a polypeptide that is identical to the polypeptide of SEQ ID NO:523 (see SEQ ID NO:3 of Fukushima et al [a] and the alignment attached to the back of this Office Action as Exhibit A). Fukushima et al [a] teach the polypeptide encoded by SEQ ID NO:3 fused to the Fc portion of an antibody as evidenced by Fukushima et al [b] (see column 7, lines 12-13 and 29-31).

Applicant is reminded that products of identical chemical composition cannot have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties (i.e., chondrocyte re-differentiation) applicant discloses and/or claims are necessarily present. In re Spada 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01.

Thus, Fukushima et al [a] as evidenced by Fukushima et al [b] anticipate the claims.

Conclusion

13. Claims 63-65 and 68 are free of the prior art and are in condition for allowance.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Blanchard whose telephone number is (571) 272-0827. The examiner can normally be reached at Monday through Friday from 8:00 AM to 6:00 PM, with alternate Fridays off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms, can be reached at

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(571) 272-0832. The official fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully,
David J. Blanchard
571-272-0827



LARRY R. HELMS, PH.D.
SUPERVISORY PATENT EXAMINER

Exhibit A

RESULT 1
US-09-700-397-3
; Sequence 3, Application US/09700397
; Patent No. 6664383
; GENERAL INFORMATION:
; APPLICANT: Ono Pharmaceutical Co., Ltd.
; TITLE OF INVENTION: No. 6664383el Polypeptides, cDNA encoding the same, and use
; FILE REFERENCE: Q61459
; CURRENT APPLICATION NUMBER: US/09/700,397
; CURRENT FILING DATE: 2001-01-05
; PRIOR APPLICATION NUMBER: JP 10-131815
; PRIOR FILING DATE: 1998-05-14
; PRIOR APPLICATION NUMBER: PCT/JP99/02485
; PRIOR FILING DATE: 1999-05-13
; NUMBER OF SEQ ID NOS: 19
; SOFTWARE: PatentIn version 3.0
; SEQ ID NO 3
; LENGTH: 344
; TYPE: PRT
; ORGANISM: Homo sapiens
; FEATURE:
; NAME/KEY: misc feature
; OTHER INFORMATION: Clone OC001 derived from human brain
US-09-700-397-3

Query Match 100.0%; Score 1806; DB 2; Length 344;
Best Local Similarity 100.0%; Pred. No. 3e-172;
Matches 344; Conservative 0; Mismatches 0; Indels 0; Gaps 0;

Qy	1	MKTIQPKMHSISWAIPTGLAALCLFQGVFVRSGDATFPKAMDNVTVRQGESATLRCTID	60
Db	1	MKTIQPKMHSISWAIPTGLAALCLFQGVFVRSGDATFPKAMDNVTVRQGESATLRCTID	60
Qy	61	NRVTRVAWLNRSTILYAGNDKWCLDPRVLLSNTQTQYSIBIQNVVDVYDEGPYTCSVQTD	120
Db	61	NRVTRVAWLNRSTILYAGNDKWCLDPRVLLSNTQTQYSIBIQNVVDVYDEGPYTCSVQTD	120
Qy	121	NHPKTSRVHLIVQVSPKIVEISSDISINEGNNISLTCTATGRPEPTVTWRHISPKAVGFV	180
Db	121	NHPKTSRVHLIVQVSPKIVEISSDISINEGNNISLTCTATGRPEPTVTWRHISPKAVGFV	180
Qy	181	SEDEYLEIQGITREQSGDYECASNDVAAPVVRVKVTNYPPIYSEAKGTGVPVQKGT	240
Db	181	SEDEYLEIQGITREQSGDYECASNDVAAPVVRVKVTNYPPIYSEAKGTGVPVQKGT	240
Qy	241	LQCRASAVPSAEFQWKDDKRLIEGKKGKVENRPFSLKLIFFNVSEHDYGNITCVASNK	300
Db	241	LQCRASAVPSAEFQWKDDKRLIEGKKGKVENRPFSLKLIFFNVSEHDYGNITCVASNK	300
Qy	301	LGHTNASIMLFGPGAVSEVSNGTSSRRAGCVWLLPLLVLHLLKLF	344
Db	301	LGHTNASIMLFGPGAVSEVSNGTSSRRAGCVWLLPLLVLHLLKLF	344